

**REMARKS**

**I. STATUS OF THE CLAIMS**

Claims 167, 168, 171, 172, 174, 175, 177, 178, 180, 181, and 185-191, 193-203, 205-208, 210-216, 218-228, 230-240, 242-245, 247-253, 255-258, 260-266, 268-278, 280-290, 292-302, 304-307, and 309-311 are now pending in this application. By this amendment, claims 169, 182, 192, 204, 209, 217, 229, 241, 246, 254, 259, 267, 279, 291, 303, and 308 are canceled. Claims 167, 168, 171, 172, 174, 175, 177, 178, 180, 181, 193, 194, 218, 230, 242, 255, 268, 280, 292, and 304 have been amended. Claims 309-311 have been added.

**II. REJECTIONS UNDER 35 U.S.C. § 103(a)**

(A) The Examiner has maintained the rejection of claims 167-169, 180-182, 185-208, and 284-307 under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,013,722 (*Yang et al.*) for the reasons disclosed at pages 4-6 of the Final Office Action and in the Advisory Action. Applicants respectfully traverse this rejection for at least the reasons of record and for the additional reasons set forth below.

*Yang et al.* neither teaches nor suggests a reshapable hair styling composition that is a shampoo having "at least one (meth)acrylic copolymer present in an amount ranging from about 0.01 to about 15 weight percent of the total weight of the composition" and "at least one surfactant present in an amount ranging from about 5 to about 30 weight percent of the composition" as recited in the present claims. Nor does *Yang et al.* teach or suggest a reshapable hair styling composition that is a conditioner

having "at least one (meth)acrylic copolymer present in an amount ranging from about 0.01 to about 15 weight percent of the total weight of the composition" and at least one cationic surfactant that is "present in an amount ranging from about 0.1 to about 15 weight percent of the composition" as recited in the present claims. Therefore, Applicants' invention is not obvious over *Yang et al.*

To establish a *prima facie* case of obviousness, three basic criteria must be met. These criteria include that there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference, and that the prior art reference must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Applicants submit that the Examiner has failed to meet these basic criteria for at least the following reasons: (1) *Yang et al.* does not teach or suggest all of the claim limitations and (2) no motivation exists to achieve the recited claim limitations. See M.P.E.P. §§ 2143.01 and 2143.03

**(1) YANG ET AL. FAILS TO TEACH OR SUGGEST  
"A HAIR STYLING" COMPOSITION.**

Applicants maintain that *Yang et al.* does not teach or suggest a hair styling composition, let alone a reshapable hair styling composition. *Yang et al.* is merely directed to non-whitening emulsion pressure sensitive adhesives suitable only for labels, decals, and the like. Col. 2, lines 20-32, col. 7, lines 16-20. Applicants also maintain that there is no motivation in *Yang et al.* to apply its adhesives to a hair styling composition. It is well known that not all pressure sensitive adhesives are suitable for hairstyling compositions. Further, the mere fact that a person of ordinary skill in the art could have made the necessary combination is not evidence of a motivation to do so.

M.P.E.P. § 2143.01. The Examiner has not denied these points; rather the Examiner has argued that the preamble is not a limitation upon the claims.

The Examiner alleges that the terms “shampoo” and “hair styling” only convey how the composition is to be used. See Advisory Action at 2. A shampoo, however, does not have the same formulation as a composition such as the pressure sensitive adhesive disclosed in *Yang et al.* While a shampoo may share a common ingredient with other compositions, one skilled in the art would readily recognize that the formulation of a pressure sensitive adhesive would not function as a shampoo. In other words, one skilled in the art would not wash their hair with a pressure sensitive adhesive because a pressure sensitive adhesive is simply not formulated to perform as a shampoo. Thus, the recitation of the terms “shampoo” and “hair styling” impart more than a mere intended use as the Examiner asserts because the terms denote a formulary distinction over a simple composition.

Furthermore, Applicants have provided three independent reasons as to why Applicants’ preamble of claims 167-169, 180-182, 185-208, and 284-307 is a limitation upon the scope of the claims that distinguishes the claims over *Yang et al.*

(1) A preamble is a limitation when one could not identify the scope of the claims without it. M.P.E.P. § 2111.02. The identification of a specific class of (meth)acrylic polymers and a surfactant in the body of each rejected claim cannot alone define Applicants’ invention. See *Rowe v. Dror*, 42 U.S.P.Q.2d 1550, 1553 (Fed. Cir. 1997).

(2) A preamble is a limitation when there is repetition of the language in the body of the claims. *Gerber Garment Technology Inc. v. Lectra Systems Inc.*, 16 U.S.P.Q.2d 1436, 1441 (Fed. Cir. 1990). Here the preamble of the rejected claims recites “a

reshapable hair styling composition” and the body recites both “a reshapable effect,” which is defined by the specification as a particular effect achieved with hair, and “shampoo,” which is a specific type of hair styling composition.

(3) A preamble is a limitation when a “review of the entirety of the [record] [gives] an understanding of what the inventors actually invented and intended to encompass by the claim.” M.P.E.P. § 2111.02; *see also, Corning Glass Works v. Sumitomo Electric U.S.A. Inc.*, 9 U.S.P.Q.2d 1962, 1966 (Fed. Cir. 1989). Here, Applicants’ specification makes it abundantly clear that Applicants did not invent all compositions that comprise the recited polymers, rather only those compositions that are (1) hair styling compositions in the form of (2) a shampoo (with respect to the rejected claims), which gives hair (3) a reshapable effect.

In response, the Examiner has asserted that “any composition comprising at least surfactant and the methacrylic polymer recited in the composition obviously has the reshapable effect.” Advisory Action at 2 (emphasis added). Applicants respectfully submit that Applicants’ claims are like those previously reviewed by the Courts and found to be structural limitations upon the claims.

In *Corning Glass Works v. Sumitomo Electric U.S.A. Inc.*, 9 U.S.P.Q.2d 1962, 1965 (Fed. Cir. 1989), the claim recited an optical waveguide comprising a cladding and a core. In holding the preamble a limitation, the Court recognized that there was more to an optical waveguide than simply identifying a cladding and a core, because not all core/cladding combinations (optical fibers) worked as an optical waveguide. *Id.* at 1966. The Federal Circuit concluded that “to read the claim in light of the specification indiscriminately to cover all types of optical fibers would be divorced from reality. The

invention is restricted to those fibers that work as waveguides as defined in the specification, which is not true with respect to fibers constructed with the limitations of paragraphs (a) and (b) only.” 9 U.S.P.Q.2d at 1966. Applicants submit that a person of ordinary skill in the art, reading Applicants’ specification, would also recognize that not all compositions are the same and, in particular, not all compositions can act as hair styling compositions. Furthermore, not all “compositions comprising at least surfactant and the methacrylic polymer recited in the composition . . . [have] the same reshapable effect” as asserted by the Examiner.

In *Kropa v. Robie*, 88 U.S.P.Q. 478, 479 (C.C.P.A. 1951), the claim recited an abrasive article comprising abrasive grains and a hardened binder. In holding the preamble a limitation, the Court recognized that the preamble gave life and meaning to the claim “for it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable inter alia of use as abrasive grains and a binder is not an ‘abrasive article.’ The term calls forth a distinct relationship between the proportions of grain and resin comprising the article.” *Id.* at 481. Applicants submit that a person of ordinary skill in the art, reading the body of the claim would similarly recognize that not every combination of a (meth)acrylic polymers and a surfactant has a reshapable effect, and therefore, the preamble is a limitation.

To support an assertion of inherency, the Examiner “must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” M.P.E.P. §2112. The Examiner’s assertion that “any composition comprising at least

surfactant and the methacrylic polymer recited in the composition obviously has the reshapable effect” is not supported by any technical reasoning or factual basis.

The Examiner suggests that paragraphs [8] through [25] list many possible uses for claimed composition. However, Applicants assert that the fact that only shampoos and conditioners are claimed clearly establishes a distinction between these two types of compositions from the others. Furthermore, claims cannot reasonably be interpreted to be broader than what is intended to be claimed. Clearly, claims specifically limited to shampoos and conditioners cannot be interpreted to encompass other formulations.

Applicants submit that that the Examiner cannot distinguish the facts surrounding the present claims and application against the facts underlying the *Corning Glass Works* and *Kropa* decisions. In view of these prior applications of the law regarding preambles, “hair styling composition” is a limitation that is “necessary to give life, meaning, and vitality” to Applicants’ claims and which *Yang et al.* does not explicitly or inherently teach.

**(2) YANG ET AL. FAILS TO TEACH OR SUGGEST  
“AT LEAST ONE SURFACTANT”.**

Applicants maintain that the Examiner has failed to establish whether *Yang et al.* expressly or inherently discloses “at least one surfactant,” as required by claims 167, 168, 180, 181, 185-191, 193-203, 205-208, 284-290, 292-302, 304-307, and 309-311. Additionally, *Yang et al.* does not teach or suggest “at least one surfactant present in an amount ranging from about 5 to about 30 weight percent of the total weight of the composition” or “at least one cationic surfactant present in an amount ranging from about 0.1 to about 15 weight percent of the total weight of the composition” as recited

by the present claims directed to shampoos and conditioners, respectively. The Examiner has argued that *Yang et al.* teaches “surfactants as additional ingredients.” Final Office Action at 4.

The Examiner further states that “Applicants’ claim is not limited to any particular vehicle or the amount or type of the surfactants present.” Advisory Action at 3. The present claims directed to a shampoo recite “at least one surfactant present in an amount ranging from about 5 to about 30 weight percent of the total weight of the composition.” Present claims directed to a conditioner now recite that the at least one surfactant is “at least one cationic surfactant present in an amount ranging from about 0.1 to about 15 weight percent of the total weight of the composition.”

Applicants respectfully disagree with the Examiner’s interpretation of *Yang et al.*’s teachings. Applicants agree that *Yang et al.* discloses the use of surfactants; however, that use is severely limited. *Yang et al.* only teaches the use of surfactants in the emulsion polymerization process from which the (meth)acrylic adhesive is a produced. Col. 4, line 65 - col. 6, line 26. Specifically, *Yang et al.* teaches the combination of various monomers and other reactants with a possible surfactant, which are then reacted to form the polymer. Col. 5, line 56- col. 6, line 26. Based on this alone, a person of ordinary skill in the art would have no basis to believe that *Yang et al.* discloses the addition of a surfactant to a (meth)acrylic polymer to form a composition. It only teaches the use of a surfactant as a reactant to form the (meth)acrylic adhesive. The Examiner has not shown that *Yang et al.* provides a broader disclosure.

To the extent that any surfactant remains unreacted after the formation of the (meth)acrylic polymer in *Yang et al.*, a person of ordinary skill in the art would recognize

that the two need to be separated and that the surfactant is not intended as an additional component for a later composition.<sup>1</sup> In fact, *Yang et al.* expressly teaches that the (meth)acrylic polymer must be separated from the resultant emulsion, which would retain any unreacted surfactant. Col. 6, lines 16-18, and Examples. This is not a mere disclosure of a preferred embodiment; rather it is the only embodiment. Moreover, this is a distinction that even *Engel et al.* (cited by the Examiner and discussed below) recognized. *Engel* at ¶¶40-41. Thus, *Yang et al.* teaches that the useful product, *i.e.*, the polymer, must be separated from any unreacted surfactant.

Since *Yang et al.* merely discloses the use of surfactants in the manufacture of a single component and not for use as an independent component in a composition, *Yang et al.* does not render Applicants' rejected claims as obvious. Furthermore, there is no motivation to modify the teachings of *Yang et al.* so as to add a surfactant to the compositions disclosed. Nor is there motivation to modify the teachings of *Yang et al.* to use the amount of surfactants as recited in the present claims. There is no suggestion of any benefits that may be obtained that would motivate a person of ordinary skill in the art to make the necessary change.

---

<sup>1</sup> To the extent that the Examiner is arguing that the intermediate emulsion polymerization product, which comprises the polymer and possible unreacted surfactant, is Applicants' composition, Applicants direct the Examiner to M.P.E.P. §2144.09, discussing *In re Lalu*, 223 U.S.P.Q. 1257, 1260 (Fed. Cir. 1984), which dictates that obviousness cannot be based on such intermediate products.



(3) **YANG ET AL. FAILS TO TEACH OR SUGGEST  
THE WEIGHT PERCENTS OF N-BUTYL ACRYLATE.**

Applicants submit maintain that *Yang et al.* fails to teach the weight percent limitations of independent claims 180 and 181 and all of the claims that depend therefrom. Specifically, claims 180 and 181 recite:

- (a) from about 30 to about 40 weight percent of units derived from at least one monomer chosen from n-butyl acrylate monomers,
- (b) from about 2 to about 10 weight percent of units derived from at least one monomer chosen from 2-hydroxy ethyl methacrylate monomers, and
- (c) from about 50 to about 70 weight percent of units derived from at least one monomer chosen from 2-ethyl hexyl acrylate monomers

In contrast, *Yang et al.* discloses the use of 50-90%, preferably 70-90% by weight n-butyl acrylate, and the use of 10-50%, preferably 10-30% by weight of a combination of monomers that may include 2-hydroxy ethyl methacrylate. Col. 3, lines 14-19. *Yang et al.* also teaches that additional monomers may optionally be included, such as 0-50%, preferably 0-30% by weight alkylacrylate monomers. Col. 3, lines 25-34. One possible alkylacrylate is 2-ethyl hexyl acrylate. Col. 3, lines 30-34.

The Examiner has admitted that *Yang et al.* does not teach or suggest “from about 30 to about 40 weight percent of units derived from at least one monomer chosen from n-butyl acrylate monomers;” however, the Examiner maintained that it would have been obvious to a person of ordinary skill in the art to modify the weight percentages because of the effect on adhesion. Final Office Action at 5. Applicants respectfully disagree. There mere fact that an act is within the skill of a person of ordinary skill does

not establish that there is a motivation to do so. M.P.E.P. § 2143.01 Nothing in *Yang et al.* suggests that it's ranges can be modified from those disclosed. M.P.E.P. § 2144.05

The Examiner has asserted that "it is within the skill of the artisan to modify the amounts of different monomers in a polymer that is an adhesive because of the expectation of increasing or decreasing the amounts of adhesion" Final Office Action at 5. Even assuming the Examiner's statement was supported in the record (and there is no cited evidence to that effect), the statement does not provide any motivation.

There is no evidence that the reduction of the amount of n-butyl acrylate monomers will yield a product that has any known or expected advantages. If this were enough to establish obviousness, then there would be no basis for any patents directed to pressure sensitive adhesives.

**(4) YANG ET AL. DOES NOT MOTIVATE A PERSON OF ORDINARY SKILL IN THE ART TO SELECT N-BUTYL ACRYLATE, 2-HYDROXY ETHYL (METH)ACRYLATE, AND 2-ETHYL HEXYL ACRYLATE MONOMERS.**

Applicants admit that the presently claimed monomers are individually disclosed in *Yang et al.*; however, they are never in the same composition. The Examiner in response has asserted that is enough for *Yang et al.* to teach 2-ethyl hexyl acrylate is an optional copolymerizable monomer in the copolymer. Final Office Action at 5. Applicants respectfully disagree.

It is well established that the mere disclosure of each and every element in a single reference is not enough to establish obviousness; there must be motivation to combine those elements found in the prior art in the manner presented in the claims, otherwise the rejection is improper. M.P.E.P. § 2143.01. Applicants submit that the

Examiner is improperly picking, choosing, and combining various disclosures within *Yang et al. In re Luvisi*, 144 U.S.P.Q. 646, 649-50 (C.C.P.A. 1965). "The examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

But for Applicants' disclosure, the Examiner has no basis to say that a person of ordinary skill in the art would select 2-ethyl hexyl acrylate. *Yang et al.* merely discloses the possible use of 2-ethyl hexyl acrylate among a list of nineteen optional monomers. See col. 2, lines 33-51. Nothing, not even a single example suggests the superiority of 2-ethyl hexyl acrylate over the other possible optional monomers. *In re Baird*, 28 U.S.P.Q.2d 1550, 1552 (Fed. Cir. 1994).

**(5) YANG ET AL. FAILS TO TEACH OR SUGGEST  
A "RESHAPABLE EFFECT."**

Applicants maintain that the reshapable effect limitation upon the claimed composition further distinguishes the claims over *Yang et al.* Here, the Examiner has asserted that "reshapable effect" is merely a use that is not given patentable weight because there are not structural differences between the claimed composition and the prior art. Final Office Action at 5.<sup>2</sup> Applicants submit that the Examiner is factually and legally incorrect.

---

<sup>2</sup> The Examiner has alleged that Applicants' mischaracterized the Examiner's statement. Final Office Action at 5. Applicants respectfully disagree in view of the fact  
(continued...)

The Examiner has cited no authority for this position and has not addressed Applicants' prior argument that this theory is inconsistent with the fact that functional limitations are a legitimate form of defining the patentable scope of the claims. M.P.E.P. § 2173.05(g), *compare* M.P.E.P. § 2114 (regarding apparatuses). Where the claim recites an intended use or property that is distinguishable over the prior art, an obviousness rejection may not be appropriate. *See In re Pearson*, 181 U.S.P.Q. 641, 644 (C.C.P.A. 1974). This has been particularly true in the art where polymers are concerned, such as in Applicants' claims. *E.I. Du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 7 U.S.P.Q.2d 1129, 1133 (Fed. Cir. 1988) ("[o]n occasion, particularly with polymers, structure alone may be inadequate to define the invention, making it appropriate to define the invention in part by property limitations.").

Finally, it remains unclear whether the Examiner has additionally asserted an inherent disclosure of the functional limitation. To the extent the Examiner has, Applicants maintain the arguments of record.

Accordingly, since there is neither factual nor legal support to conclude that *Yang et al.* teaches or suggests each and every limitation of the present claims, as required for a *prima facie* case of obviousness, the rejection under Section 103(a) should be withdrawn. *See* M.P.E.P. § 2143.

---

(...continued)

that Applicants' directly quoted the rejection and identified M.P.E.P. sections that contradict the quoted statement.

(B) The Examiner has maintained the rejection of claims 167-169, 171, 172, 174, 175, 177, 178, 180-182, and 185-308 under 35 U.S.C. § 103(a) as obvious over U.S. Patent Application No. 2002/0058754 (*Engel et al.*) in view of *Yang et al.* for the reasons disclosed at pages 6-7 of the Final Office Action. Applicants respectfully traverse this rejection for at least the reasons of record and for the additional reasons set forth below.

Specifically, the Examiner has not and cannot establish, *inter alia*, that (1) the combination of *Engel et al.* and *Yang et al.* teach or suggest all of the claim limitations, or (2) a motivation exists to achieve the recited claim limitations. See M.P.E.P. §§ 2143.01 and 2143.03.

A. **THE REFERENCES FAIL TO TEACH OR SUGGEST  
ALL OF THE CLAIM LIMITATIONS**

(1) **“A HAIR STYLING” COMPOSITION**

Applicants submit that the preamble of claims 167, 168, 171, 172, 174, 175, 177, 178, 180, 181, 185-191, 193-203, 205-208, 210-216, 218-228, 230-240, 242-245, 247-253, 255-258, 260-266, 268-278, 280-290, 292-302, 304-307, and 309-311 is a limitation upon the scope of the claims that distinguishes the claims over the prior art. As discussed above, *Yang et al.* merely teaches a pressure sensitive adhesive suitable for labels, decals, and the like. Col. 2, lines 20-32, col. 7, lines 16-20. Similarly, *Engel et al.* merely discloses pressure sensitive adhesives needing a backing for application to the skin. ¶¶10, 18, 55 (describing BIORE®-type product). Neither reference teaches or suggests a hair styling composition.

The Examiner has responded that the preamble has no patentable weight. Final Office Action at 6-7. Applicants submit that the preamble does have patentable weight for the reasons presented above and incorporated herein by reference.

**(2) “AT LEAST ONE CONDITIONER”**

Applicants submit that the Examiner has failed to establish that *Engel et al.* in view of *Yang et al.* expressly or inherently discloses “at least one conditioning agent,” as required by claims 171, 172, 174, 175, 177, 178, and 210-283. The Examiner has relied upon *Engel et al.*, asserting that *Engel et al.* discloses moisturizers. Final Office Action at 7. The Examiner has further asserted that the term “at least one conditioner” is “not limited to any specific compound or how the conditioning agent is to be used.” Advisory Action at 6.

The Examiner’s position is inconsistent with the Applicants’ right to define terms in the specification. See M.P.E.P. §2111.01; *In re Zletz*, 13 U.S.P.Q.2d 1320, 1322 (Fed. Cir. 1989) (The court held that “words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification.”). As clearly defined in Applicants’ specification, “the term ‘conditioning agent’ means any agent whose function is to improve the cosmetic properties of the hair, for example, the softness, ease of disentangling, feel, and lack of static electricity.” Specification at ¶50. In contrast, *Engel et al.* discloses the use of “skin moisturizers” and “skin conditioning agents,” which is consistent with its limited disclosure of products suitable for skin. Abstract, ¶9. Applicants submit that one of ordinary skill in the art would recognize the distinction between skin conditioning agents/moisturizers and hair conditioning agents.

Vol. 2, INTERNATIONAL COSMETIC INGREDIENT DICTIONARY AND HANDBOOK, 1721, 1752, 1767 (8th ed. 2000) (courtesy copy enclosed). Furthermore, contrary to the Examiner's assertion that the term "conditioning agent" is not limited to any specific compound, Applicants' definition of conditioning agents clearly requires the agent to function to "improve the cosmetic properties of the hair." Thus, the conditioning agent is limited to a specific class of compounds. Accordingly, *Engel et al.*'s disclosure is inadequate to render the claims obvious.

(3) **WEIGHT PERCENT LIMITATIONS OF N-BUTYL ACRYLATE, 2-HYDROXY ETHYL (METH)ACRYLATE, AND 2-ETHYL HEXYL ACRYLATE MONOMERS**

Applicants maintain that neither *Engel et al.* nor *Yang et al.* teaches the weight percent limitations of independent claims 177, 178, 180, and 181 and all of the claims that depend therefrom. For the very same reasons discussed above and incorporated herein by reference, *Yang et al.* does not teach or suggest Applicants' limitation: "from about 30 to about 40 weight percent of units derived from at least one monomer chosen from n-butyl acrylate monomers." *Engel et al.* does not correct this deficiency, in view of the fact that *Engel et al.*'s only teaching for weight percentages is directed to the amount of vinyl monomers; at least 80 parts, based on 100 parts total monomer content. ¶33.

In response the Examiner has assert that it would have been obvious to a person of ordinary skill in the art to modify the weight percentages because of the effect on adhesion. Final Office Action at 5. As discussed above, the prerequisites for such an argument have not been addressed by the Examiner, and, thus, there is no established

motivation to modify the teachings of the references. See M.P.E.P. §§ 2143.01 & 2144.05(II)(B).

(4) **A “RESHAPABLE EFFECT”**

Applicants maintain that the reshapable effect limitation upon the claimed composition further distinguishes the claims over the combination of *Engel et al.* and *Yang et al.* As above, the Examiner has asserted that “reshapable effect” is merely a use that is not given patentable weight because there are not structural differences between the claimed composition and the prior art. Final Office Action at 5. Applicants submit that the Examiner is factually and legally incorrect for the same reasons presented above and incorporated herein by reference.

Since there is neither factual nor legal support to conclude that *Engel et al.* in combination with *Yang et al.* teaches or suggests each and every limitation of the present claims, the rejection under Section 103(a) should be withdrawn. See M.P.E.P. § 2143.

**B. THERE IS NO MOTIVATION IN THE REFERENCES  
TO DUPLICATE THE CLAIMS’ SELECTION OF MONOMERS**

As discussed above, Applicants admit that the presently claimed monomers are individually disclosed in *Yang et al.*; however, they are never in the same composition. In view of the Examiner’s response, it is Applicants’ understanding that the Examiner does not rely upon *Engel et al.* to establish this limitation. Accordingly, Applicants incorporate their arguments from above.



**C. THERE IS NO MOTIVATION IN TO USE YANG ET AL.'S POLYMERS IN  
ENGEL ET AL.'S SKIN COMPOSITIONS**

Applicants have argued that the Examiner must show that there was some motivation in the art for a person of ordinary skill in the art to combine *Yang et al.*'s polymers with *Engel et al.*'s skin compositions. See, M.P.E.P. § 2143.01. The Examiner asserts that it is enough that *Engel et al.* discloses the same monomers as *Yang et al.* (Final Office Action at 7) and that it would have been obvious to substitute one pressure sensitive adhesive for another pressure sensitive adhesive. September 10, 2003 Office Action at 7. Applicants respectfully disagree.

The mere fact that *Engel et al.* discloses the same classes of monomers cannot be deemed a disclosure of the same polymers. The monomers at issue are well known in the art and used to create polymers of very diverse types and uses. Applicants submit that a person of ordinary skill in the art would not deem such a broad disclosure a basis for combining teachings. Moreover, the polymers of *Engel et al.* are not the same as the polymers of *Yang et al.* In contrast to *Yang et al.*, *Engel et al.* requires the use of an acid monomer and the use of metal oxide in the formation of the polymers. ¶32.

In addition, the M.P.E.P. has explained that "the mere fact that references can be combined . . . does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01. While the Examiner has suggested that water resistance and low haze of *Yang et al.*'s polymer is a motivation (9/10/03 Office Action at 7), the Examiner has yet to address the fact that there is no respective need in *Engel et al.* *Engel et al.* already teaches that its

composition comprises hydrophobic coating, so there is no need for *Yang et al.*'s water resistance polymer. ¶¶55-58. Moreover, *Engel et al.* explains that it is desirable to have a nearly white adhesive and not a clear adhesive. ¶51. Hence, *Engel et al.* teaches away from the proposed combination for the very reason the Examiner has asserted is a motivation to combine.

In view of *Engel et al.*'s and *Yang et al.*'s deficiencies detailed above, claims 167-169, 171, 172, 174, 175, 177, 178, 180-182, and 185-308 are not rendered obvious. Applicants respectfully request withdrawal of this rejection.


### III. CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

By: 

Mark D. Sweet  
Reg. No. 41,469

Dated: June 3, 2005